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10/057,521	01/24/2002	Nobuyuki Tanaka	15225	4332

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EXAMINER

ARANI, TAGHI T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,521	TANAKA, NOBUYUKI	
	Examiner	Art Unit	
	Taghi T. Arani	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/24/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,13-28,31-46 and 49-55 is/are rejected.
- 7) ☒ Claim(s) 2,3,11,12,20,21,29,30,38,39,47,48,56 and 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/24/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-57 are examined and pending.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1, 4-8, 10, 13-17, 19, 22-26, 28, 31-35, 37, 40-44, 46, 49-53, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al, US patent 6,674,874 (hereinafter "Yoshida").

As per claims 1 and 19, Yoshida teaches an encrypting apparatus and method using an encryption key contained in an electronic watermark, said apparatus comprising (Abstract, Fig. 12 and associated text):

generating means for generating a first electronic watermark which contains a first encryption key (Col. 12, lines 1-5, the decoding key is embedded as digital watermark) ;

electronic watermark inserting means for inserting said first electronic watermark containing said first encryption key into a first portion of data (Col. 12, lines 19-127, i.e. the decrypting key is embedded in the imputed image corresponding to the head of audio block by the digital watermark embedding unit 1205); and

encrypting means for encrypting a second portion of said data with said first encryption key (Col. 12, lines 15-17, the encrypting unit 1203 enciphers each block of audio data by using the encrypting key generated by the key generating unit 1202).

As per claims 4-5 and 22-23, Yoshida teaches the encrypting apparatus and method as set forth in claims 1 and 19 respectively, further comprising: compressing means for compressing said data and that the compressing means compresses said data before said data is encrypted (Col. 15, lines 64 through col. 16, lines 12, Yoshida's digital watermark embedding and encryption is performed in contents including a plurality of objects as an MPEG-4 (compressing means) image or the like, i.e., see also Col. 13, lines 5-15, wherein hash function is used as a compressing means).

As per claims 6 and 24, Yoshida the encrypting apparatus and method as set forth in claims 1 and 19 respectively, wherein said data contain at least one of video data, audio data, and character data (Col. 4, lines 50-64).

As per claims 7 and 25, Yoshida teaches the encrypting apparatus as set forth in claims 1 and 19, wherein said first portion and said second portion are output to the same medium (Col. 4, lines 60-64, see also Fig. 1 and associated text).

As per claims 8 and 26, Yoshida teaches the encrypting apparatus as set forth in claims 1 and 18 respectively, wherein said second portion is output to a medium different from a medium to which said first portion is output (Fig. 12 and associated text, Col. 12, lines 16-27, the encrypting unit 1203 enciphers each block of the audio data and provide an "AUDIO OUTPUT" and as for the imputed image data, the resultant embedded frames are inputted to the storage unit 1206, see also col. 11, lines 24-36).

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As per claim 10 and 28, Yoshida teaches a decrypting apparatus and method using an encryption key contained in an electronic watermark, said apparatus comprising (Abstract, Fig. 13 and associated text):

electronic watermark detecting means for detecting a first electronic watermark from a first portion of data (Col. 12, lines 31-32, frame cutting-out unit 1301);

encryption key extracting means for extracting a first encryption key from said first electronic watermark (Col. 12, lines 46-48, the digital watermark extracting unit 1302 extracts the decoding key embedded as a signal watermark in the frame); and

decrypting means for decrypting a second portion of said data with said first encryption key (Col. 12, lines 49-55, the decoding unit 1304 decodes the audio block using decoding key).

As per claims 13-14 and 31-32, Yoshida teaches the decrypting apparatus and method as set forth in claims 10 and 27 respectively, further comprising:

expanding means for expanding said data, wherein said expanding means expands said data after said data is decrypted ((Col. 15, lines 64 through col. 16, lines 12, Yoshida's digital watermark embedding and encryption/decryption are performed in contents including a plurality of objects as an MPEG-4 (compressing/expanding) image or the like, i.e., see also Col. 13, lines 5-15, wherein hash function is used as a compressing means).

As per claims 15 and 33, Yoshida teaches the decrypting apparatus and method as set forth in claims 10 and 28 respectively, wherein said data contain at least one of video data, audio data, and character data (Col. 4, lines 50-64).

As per claims 16 and 34, Yoshida teaches the decrypting apparatus as set forth in claims 10 and 28 respectively, wherein said first portion and said second portion are input from the same medium (Fig. 2 and associated text, Col 6, lines 1-12, i.e. the recording medium, separating it into an audio signal and an image signal).

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As per claim 17 and 35, Yoshida teaches the decrypting apparatus and method as set forth in claims 10 and 28 respectively, wherein said second portion is input from a medium different from a medium from which said first portion is input (Fig. 13 and associated text, where “IMAGE DATA” and “AUDIO DATA” are inputted (i.e. different media)).

Claims 37,40-44,46,49-53, and 55 are computer program products embodying instructions to perform the method of claims 19, 22-26, 28, 31-35. Yoshida teaches computer program products embodying instructions to perform the method of Claims 19, 22-26, 28, and 31-35 respectively (see Col. 16, lines 21-35).

Claims 37,40-44,46,49-53, and 55 are rejected for same reasons provided in the rejection of claims 37,40-44,46,49-53, and 55 over Yoshida (see Col. 16, lines 21-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 18, 27, 36, 45, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claims 1, 19 and 28 above, and further in view of US patent 6,535,269 to Sherman (hereinafter “Sherman”).

As per claims 9, 18, and 27, Yoshida teaches apparatus and method of claims 1, 10, and 19 respectively except wherein said first portion contains a commercial.

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However, Sherman teaches method and system for customizing a motion film selection by selecting a film clip (downloadable including a video track and a sound track) wherein watermark technology is used to encode information about the owner of the downloadable material and that only the degraded or preview version (i.e. portion containing commercial) of the video could be redistributed by the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Sherman into the apparatus and method of Yoshida to have the first portion (i.e. the watermarked portion) contain commercial for only preview before buy which should actually be encouraged (Sherman , Col. 7, lines 28-30).

Claims 36, 45, and 54 are computer program products embodying instructions to perform the method of claims 9, 18, and 27 respectively. Yoshida teaches computer program products embodying instructions to perform the method of claims 9, 18, and 27 respectively (see Col. 16, lines 21-35).

Allowable Subject Matter

Claims 2-3, 11-12, 29-30, 38-39, and 47-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note: Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the

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entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Prior arts made of record, not relied upon:

US 5,613,004 to Cooper man et al.

US 5,991,426 to Cox et al.

US 6,01,849 Orrin, Steven M.

US 6,243,480 to Zhao et al.

US 6,301,663 to Kato et al.

US 2002/0150239 to Carny et al.

US 6,560,339 to Iwamura et al.

US 2003/0194109 to Acharya et al.

US 2003/0009669 to White et al.

US 6,611,599 to Natarajan , Balas K.

US 6,353,672 to Rhoads, Geoffrey B.

US 6,523,113 to Wehrenberg Paul J.

US 2003/0023847 to Ishibashi et al.

US 2004/0264735 to Rhoads, Geoffrey B.

US 6,804,377 to Reed et al.

US 6,954,854 to Miura et al.

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US 2001/0004736 Hirano et al.

US 2005/0039022 to Venkatesan et al.

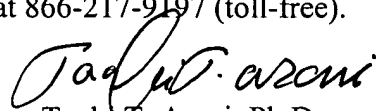
US 6,519,352 to Rhoads Geoffery B.

US 6,957,350 to Demos, Gary A.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Examiner

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3/2/2006